

File
Patent Reg.

REGULATIONS CONCERNING INVENTIONS MADE BY GOVERNMENT EMPLOYEES

TITLE 37—PATENTS, TRADEMARKS, AND COPYRIGHTS

Chapter III—Government Inventions Jurisdiction, Patent Office, Department of Commerce

PART 300—ADMINISTRATION OF A UNIFORM PATENT POLICY WITH RESPECT TO THE DOMESTIC RIGHTS IN INVENTIONS MADE BY GOVERNMENT EMPLOYEES

The heading of Chapter III, Title 37, is changed to read as set forth above.

This part is a revision of the former Part 300, 16 F.R. 3927. Parts 301 and 302 remain unchanged.

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AUTHORITY: §§300.1 to 300.11 issued under sec. 4, E.O. 10096, Jan. 23, 1950, 15 F.R. 391 as amended by E.O. 10930, Mar. 24, 1961, 26 F.R. 2583; and Delegation of Authority by the Acting Secretary of Commerce, Mar. 24, 1961, 26 F.R. 3118.

§ 300.1 Purpose.

The purpose of this part is to provide for the administration of a uniform patent policy for the Government with respect to the domestic rights in inventions made by Government employees and to prescribe rules and regulations for implementing and effectuating such policy.

§ 300.2 Authority.

Authority for the administration of a uniform patent policy is provided in Executive Order 10096, dated January 23, 1950, 15 F.R. 389, as amended by E.O. 10930, Mar. 24, 1961, 26 F.R. 2583, and Delegation of Authority by Acting Secretary of Commerce, Mar. 24, 1961, 26 F.R. 3118.

§ 300.3 Scope.

This part applies to any invention made by a Government employee on or after January 23, 1950, and to any action taken with respect thereto.

§ 300.4 Definitions.

(a) The term "Government agency," as used in this part, means any Executive department or independent establishment of the Executive branch of the Government (including any independent regulatory commission or board, any corporation wholly owned by the United

States, and the Smithsonian Institution), but does not include the Atomic Energy Commission.

(b) The term "Government employee," as used in this part, means any officer or employee, civilian or military, of any Government agency, including any part-time consultant or part-time employee except as may otherwise be provided for by agency regulation approved by the Commissioner.

(c) The term "invention," as used in this part, means any art, machine, manufacture, design, or composition of matter, or any new and useful improvement thereof, or any variety of plant, which is or may be patentable under the patent laws of the United States.

(d) The term "Commissioner," as used in this part means the Commissioner of Patents or any Assistant Commissioner who may act for the Commissioner of Patents.

§ 300.5 Determination of invention.

Each Government agency will determine whether the results of research, development, or other activity within the agency constitute invention within the purview of Executive Order 10096, as amended by Executive Order 10930.

§ 300.6 Determination of rights in and to inventions.

(a) Subject to review by the Commissioner as provided for in this part, each Government agency will determine the respective rights of the Government and of the inventor in and to any invention made by a Government employee while, under the administrative jurisdiction of such agency.

(b) The following rules shall be applied in determining the respective rights of the Government and of the inventor in and to any invention that is subject to the provisions of this part:

(1) The Government shall obtain, except as herein otherwise provided, the entire domestic right, title and interest in and to any invention made by any Government employee (i) during working hours, or (ii) with a contribution by the Government of facilities, equipment, materials, funds or information, or of time or services of other Government employees on official duty, or (iii) which bears a direct relation to or is made in consequence of the official duties of the inventor.

(2) In any case where the contribution of the Government, as measured by any one or more of the criteria set forth in subparagraph (1) of this paragraph, to the invention is insufficient equitably to justify a requirement of assignment to the Government of the entire domestic right, title, and interest in and to such invention, or in any case where the Government has insufficient interest in an invention to obtain the entire domestic right, title, and interest therein (although the Government could obtain same under subparagraph (1) of this paragraph), the Government agency concerned shall leave title to such invention in the employee, subject however, to the reser-

vation to the Government of a nonexclusive, irrevocable, royalty-free license in the invention with power to grant licenses for all governmental purposes, such reservation, in the terms thereof or where applicable in the terms required by 35 U.S.C. 266, to appear, where practicable, in any patent, domestic or foreign, which may issue on such invention.

(3) In applying the provisions of sub-paragraphs (1) and (2) of this paragraph to the facts and circumstances relating to the making of a particular invention, it shall be presumed that an invention made by an employee who is employed or assigned (i) to invent or improve or perfect any art, machine, design, manufacture, or composition of matter, (ii) to conduct or perform research, development work, or both, (iii) to supervise, direct, coordinate, or review Government financed or conducted research, development work, or both, or (iv) to act in a liaison capacity among governmental or non-governmental agencies or individuals engaged in such research or development work, falls within the provisions of subparagraph (1) of this paragraph, and it shall be presumed that any invention made by any other employee falls within the provisions of subparagraph (2) of this paragraph. Either presumption may be rebutted by a showing of the facts and circumstances and shall not preclude a determination that these facts and circumstances justify leaving the entire right, title and interest in and to the invention in the Government employee, subject to law.

(4) In any case wherein the Government neither (i) obtains the entire domestic right, title and interest in and to an invention pursuant to the provisions of subparagraph (1) of this paragraph nor (ii) reserves a nonexclusive, irrevocable, royalty-free license in the invention, with power to grant licenses for all governmental purposes, pursuant to the provisions of subparagraph (2) of this paragraph, the Government shall leave the entire right, title and interest in and to the invention in the Government employee, subject to law.

(c) In the event that a Government agency determines, pursuant to paragraph (b) (2) or (4) of this section, that title to an invention will be left with an employee, the agency shall notify the employee of this determination and promptly prepare, and preserve in appropriate files, accessible to the Commissioner, a written, signed, and dated statement concerning the invention including the following:

(1) A description of the invention in sufficient detail to identify the invention and show its relationship to the employee's duties and work assignments;

(2) The name of the employee and his employment status, including a detailed statement of his official duties and responsibilities at the time the invention was made; and

(3) A statement of agency determination and reasons therefor. The agency shall, subject to considerations of national security, or public health, safety, or welfare, submit to the Commissioner a copy of this written statement. This submittal in a case falling within the provisions of paragraph (b) (2) of this section shall be made after the expiration of the period prescribed in § 300.7 for the taking of an appeal, or it may be made prior to the expiration of such period if the employee acquiesces in the

agency determination. The Commissioner thereupon shall review the determination of the Government agency, and his decision respecting the matter shall be final, subject to the right of the employee or the agency to submit to the Commissioner within 30 days (or such longer period as the Commissioner may, for good cause, shown in writing, fix in any case) after receiving notice of such decision, a petition for the reconsideration of the decision. A copy of any such petition must also be filed by the inventor with the employing agency within the prescribed period.

§ 300.7 Appeals by employees.

(a) Any Government employee who is aggrieved by any agency determination pursuant to § 300.6(b) (1) or (2) may obtain a review of the agency determination by filing, within 30 days (or such longer period as the Commissioner may for good cause shown in writing, fix in any case) after receiving notice of such determination, two copies of an appeal with the Commissioner. The Commissioner then shall forward one copy of the appeal to the agency.

(b) On receipt of a copy of an appeal filed pursuant to paragraph (a) of this section, the Government agency which made the determination shall, subject to considerations of national security, or public health, safety, or welfare, promptly furnish both the Commissioner and the inventor with a copy of a report containing the following information about the invention involved in the appeal:

(1) A copy of a statement by the agency containing the information specified in § 300.6(c), and

(2) A detailed statement of the points of dispute or controversy, together with copies of any statements or written arguments filed with the agency, and of any other relevant evidence that the agency considered in making its determination of Government interest. Within 25 days (or such longer period as the Commissioner may, for good cause shown, fix in any case) after the transmission of a copy of the agency report to the employee, the employee may file a reply thereto with the Commissioner and file one copy thereof with the agency.

(c) After the time for the inventor's reply to the Government agency's report has expired and if the inventor has so requested in his appeal, a date will be set for the hearing of oral arguments by the employee (or by an attorney whom he designates by written power of attorney filed before, or at the hearing) and a representative of the Government agency involved. Unless it shall be otherwise ordered before the hearing begins, oral arguments will be limited to thirty minutes for each side. The employee need not retain an attorney or request an oral hearing to secure full consideration of the facts and his arguments. He may expedite such consideration by notifying the Commissioner when he does not intend to file a reply to the agency report.

(d) After a hearing on the appeal, if a hearing was requested, or after expiration of the period for the inventor's reply to the agency report if no hearing is set, the Commissioner shall issue a decision on the matter, which decision shall be final after the period for asking reconsideration expires or on the date that a decision on a petition for reconsideration is finally disposed of. Any

request for reconsideration or modification of the decision must be filed within 30 days from the date of the original decision (or within such an extension thereof as may be set by the Commissioner before the original period expires). The Commissioner's decision shall be made after consideration of the statements of fact in the employee's appeal, the agency's report, and the employee's reply, but the Commissioner, at his discretion and with due respect to the rights and convenience of the inventor and the Government agency, may call for further statements on specific questions of fact or may request additional evidence in the form of affidavits or depositions on specific facts in dispute.

§ 300.8 Patent protection.

(a) A Government agency, upon determining that an invention coming within the scope of § 300.6(b) (1) or (2) has been made, shall thereupon determine whether patent protection will be sought in the United States by the agency for such invention. A controversy over the respective rights of the Government and of the employee in any case shall not delay the taking of the actions provided for in this section. In cases coming within the scope of § 300.6(b)(2), agency action looking toward such patent protection shall be contingent upon the consent of the employee.

(b) Where there is a dispute as to whether § 300.6(b) (1) or (2) applies in determining the respective rights of the Government and of an employee in and to any invention, the agency will determine whether patent protection will be sought in the United States pending the Commission's decision on the dispute, and, if it decides that an application for patent should be filed, will take such rights as are specified in § 300.6(b)(2), but this shall be without prejudice to acquiring the rights specified in subparagraph (1) of that paragraph should the Commissioner so decide.

(c) Where an agency has determined to leave title to an invention with an employee under § 300.6(b)(2), the agency will, upon the filing of an application for patent and pending review of the determination by the Commissioner, take the rights specified in that subparagraph without prejudice to the subsequent acquisition by the Government of the rights specified in subparagraph (1) of that paragraph should the Commissioner so decide.

(d) In the event that a Government agency determines that an application for patent will not be filed on an invention made under the circumstances specified in § 300.6(b)(1), giving the United States the right to title thereto, the agency shall, subject to considerations of national security, or public health, safety, or welfare, re-

port to the Commissioner, promptly upon making such determination, the following information concerning the invention:

(1) Description of the invention in sufficient detail to permit a satisfactory review;

(2) Name of the inventor and his employment status; and

(3) Statement of agency determination and reasons therefor. The Commissioner may, if he determines that the interest of the Government so requires and subject to considerations of national security, or public health, safety, or welfare, bring the invention to the attention of any Government agency to whose activities the invention may be pertinent, or cause the invention to be fully disclosed by publication thereof; *Provided, however,* That no application for patent respecting any variety of plant invented by an employee of the Department of Agriculture shall be filed without the approval of the Secretary of Agriculture.

§ 300.9 Report forms.

The Commissioner will prescribe the forms to be used by Government agencies in submitting the reports specified in this part.

§ 300.10 Liaison.

Each Government agency shall designate a liaison officer at the agency level to deal with the Commissioner: *Provided, however,* That the Departments of the Army, the Navy, and the Air Force may each designate a liaison officer.

§ 300.11 Dissemination of this part.

Each Government agency shall make appropriate arrangements for the dissemination to its employees of the provisions of this part.

Effective date.—Administrative Order No. 5, dated April 26, 1951, codified as former Part 300, 16 F.R. 3927, is revised by the provisions of this part, which shall go into effect 60 days after the date of approval and remain in effect until further notice.

EDWIN L. REYNOLDS,
Acting Commissioner of Patents.

Approved: February 6, 1962.

JOHN F. KENNEDY,
President.

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